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SEP 04 2003

In re Application of  
Weihs et al.  
Application No. 09/846,486  
Filed: May 1, 2001  
Attorney Docket No. 13631-2

**OFFICE OF PETITIONS**

**ON PETITION**

This decision concerns the "Petition under 37 CFR 1.181 - Request for Reinstating Filing Date" filed on June 16, 2003, which is being properly treated as a petition under 37 CFR 1.53(e).<sup>1</sup>

The petition is **GRANTED**.

**BACKGROUND**

On May 1, 2001, the application was filed. On February 13, 2002, the Office of Initial Patent Examination mailed a Notice of Incomplete Nonprovisional Application ("2/13/02 Notice"), stating that the application had not been accorded a filing date because it was deposited without drawings.

On April 18, 2002, in response to the 2/13/02 Notice, Applicants submitted 6 sheets of drawings containing Figures 1-8 and 9A-B, under a transmittal captioned "Preliminary Amendment." This transmittal did not dispute the 2/13/02 Notice, but merely conveyed that: (1) Figures 1-5, as contained in Provisional Application No. 60/201,293, were incorporated into this application by reference; (2) The remaining figures, i.e., Figures 6-8, 9A-B, were not necessary for understanding the claimed invention in this application.

Subsequently, the filing date for this application was changed from May 1, 2001 to April 18, 2002.

Neither the instant petition nor the April 18, 2002 submission includes a copy of Applicants' postcard receipt, listing and itemizing the papers being mailed with the postcard on May 1, 2001, and date-stamped by the USPTO.

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<sup>1</sup> This petition was recently received in the Office of Petitions. Apparently, similar requests for a corrected filing date had been filed before allowance, on 9/20/02 by facsimile and again on 9/25/02, but were never forwarded to this Office for action. The Office sincerely apologizes for any inconvenience caused by the delay.

## DISCUSSION

### This application is entitled to a May 1, 2001 filing date without any drawings

As stated in MPEP 601.01(f) (Rev. 1, Feb. 2003), it is the practice of the USPTO to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

MPEP 601.01(f) also states that:

A nonprovisional application having at least one claim . . . directed to the subject matter . . . for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but **filed without drawings** will be treated as an application **filed without all of the drawing figures referred to in the specification** as discussed in MPEP 601.01(g), so long as the application contains something that can be construed as a written description. (emphasis added)

This application, upon filing on May 1, 2001, included 32 method claims. Therefore, the application should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP 601.01(g).

MPEP 601.01(g) states that if an application is filed without all of the drawing figure(s) referred to in the specification, a “Notice of Omitted Item(s)” is mailed indicating that the application has been accorded a filing date, but is lacking some of the figures of drawings described in the specification.

In view of the above, the 2/13/02 Notice was mailed in error and is hereby withdrawn.

The application, consisting of the papers received in the USPTO on May 1, 2001, is hereby accorded the requested filing date of May 1, 2001. The petition is thus **GRANTED**.

### Incorporation by reference

The petition also argues in Section (III) (page 5) that the contents of all the drawings in the instant application (Figures 1-8, 9A-B) were disclosed in the earlier Provisional Application, No. 60/201,293. This argument is inconsistent with the title of this section: “Useful Drawings are Incorporated by Reference from the Provisional Application.” The mechanism set forth in this argument clearly is not “incorporation by reference.”

Unfortunately, the petition containing this argument was not presented to the USPTO until two weeks after the application had been allowed, when the determination should appropriately be made by the Examiner.

The Office notes, however, that:

- (A) The specification filed on May 1, 2001 referred to three applications, one being Provisional Application No. 60/201,292, but did not provide the serial numbers for the other two applications. The specification states under "Cross Reference to Related Applications" that "[t]hese three related applications are incorporated herein by reference."
- (B) The April 18, 2002 Preliminary Amendment mentions only Figures 1-5 contained in Provisional Application No. 60/201,292 being incorporated by reference into the instant application.
- (C) Provisional Application No. 60/201,292, a copy of which is supplied with the instant petition, includes only 4 sheets of drawings containing Figures 1-6.

In summary, on May 1, 2001 when the instant application was filed, the disclosure in Provisional Application No. 60/201,292, including that in the drawings, were, through the incorporation-by-reference clause in the May 1, 2001 specification, incorporated into the instant application.

### CONCLUSION

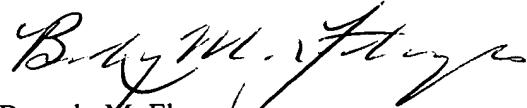
The papers received in the USPTO on May 1, 2001, i.e., **not including any drawings**, are accorded that filing date.

No petition fee is owed.

The application is being returned to the Office of Initial Patent Examination for correcting the filing date to May 1, 2001; for mailing a corrected filing receipt reflecting that filing date; and for indication in USPTO records that "0" sheets of drawings were present on the May 1, 2001 filing date.

Thereafter, the application will be forwarded to Technology Center 1700 for examination of the Request for Continued Examination (RCE) apparently filed on August 28, 2003. The USPTO record does not show payment of the issue fee.

Telephone inquiries should be directed to Petitions Attorney RC Tang at (703) 308-0763.



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